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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,531	09/15/1999	RANDALL A. ADDINGTON	99-1001	7582

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[REDACTED] EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 27

Application Number: 09/396,531

Filing Date: September 15, 1999

Appellant(s): ADDINGTON ET AL.

Joel Rosenblatt
For Appellant

EXAMINER'S ANSWER

This is in response to the Remand to the Examiner filed 9/26/02.

(1) The status of the Amendment AF filed March 6, 2001 is as stated in the Advisory Action, paper No. 12. As **not entered**. Examiner's comments at the bottom of the Advisory Action are intended only to communicate with applicant where his efforts have advanced the prosecution of the case. It should be plain to the Board that the amendment to claim 16 made by the applicant is merely a single notation of form in the alphabetic lettering of the paragraphs in the body of the claim and that the cancellation of claim 18 resolves all issues with respect thereto. However, applicant chose not to file a subsequent AF amendment to have these changes formally entered. No entry "in part" of the amendment was done. The following clarifications are made to the Examiners Answer, paper No. 17;

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 3/6/01 has not been entered. The errors present in the alphabetic lettering to claim 16 and claim 18 remain.

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(8) *ClaimsAppealed*

A substantially correct copy of appealed claim 16 appears on page 31 of the Appendix to the appellant's brief. The minor errors are as follows: on line 12, "c" should read -d-. See pg. 4 of paper No. 6 for a complete copy of the claim.

A substantially correct copy of appealed claim 18 appears on page 5 of paper No. 6. This claim was omitted from the Appendix to the appellant's brief.

(9) *Prior Art of Record*

617,929	Fowble	1-1899
5,881,388	Pratt	3-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims should be amended to remove positive recitations to "the bowling ball" (note claim 1, paragraph c) so as not to imply that the bowling ball is being claimed in combination with the finger shield. Likewise, the scope of claims new claims 16 and 19 are unclear in that one cannot determine if the bowling ball is being claimed in combination with the finger pad shield. While the ball is functionally recited in the preamble, it is positively referred to in the body of the claim. The preamble and the body of the claim must be in harmony. Further, the claim positively recites "the bowler" and "said bowler's finger" implying that such is also being claimed in combination which is improper. Claims 17 and 20 is indefinite since one cannot determine what the range may be. A child is not as strong as an adult. Further the lift produced and the force developed on the finger depends on the technique and method used by a person. Each is individual and techniques would tend to produce a greater "maximum force" than others. For example, the point if the point of release of the ball by a bowler in the arch of the swing of the arm is low the force

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would be low and if the release point is high the forces due to lift would also be high. The english used in claim 18 is disjointed and one cannot determine the scope of the structure intended to be further limited. Claims 25 and 26 contradict claim 24 such that one cannot determine the scope of the claim.

I. **Claims 15, 17-20, 22 and 23 are further objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.**

II. **Claims 1-5, 9-23 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble.**

Note marked examiner's marked copy of Fowble included with this action. As to claims 1, 3, 15-23 and 27-31, Fowble shows a finger pad A, having a pad shield means with a first curved surface 1 and a second surface 2 including a contact area at 3. The recitations in paragraph c. are functional and fail to distinguish over Fowble. Further shown by him is a "means for placing" by slipping the finger into the shield and the shield is made of rigid material. As to claim 2, he further shows two side walls terminating in an end at c. The shield is open at c as called by claim 4. At the reference marked 4, he shows a closed end called for by claim 5. As to claims 9, 11 and 27, strap 5 is capable of functioning as a "limit means" and is considered a "raised surface" as called for in claim 10. Reference 6 is considered a "support means" as called for by claim 12-14.

III. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

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patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 6-8 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt.

As to claim 6, Pratt shows combining finger inserts with gloves in order to position them on the hand. To have included a glove in combination with the insert shown by Fowble would have been obvious in order to keep hold the insert and to further protect the rest of the hand.

(2) Additional independent claim fees are **not required**. These claims are being treated as dependent claims in scope. If the Board feels otherwise then it should enter the new grounds of rejection under 35 USC 112.

(3)(first occurrence) As recognized by the Board, The "means for placing" is treated by the Examiner Answer (top of pg. 3) and all the way back in the prosecution at the bottom of pg. 2 of paper No. 5. The "means for performing a function" is clearly shown by the applied art establishing a *prima facie* case.

(3)(second occurrence) A marked copy of Fowble is attached to this action.

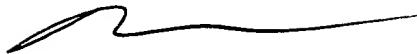
(4) Mariness has been removed from the grounds of rejection as set forth in above.

(5) Claim 15 has been rejected as being both indefinite and for being dependent upon a rejected base claim. Note pg. 7, beginning at 2nd full paragraph of paper No. 10 and bottom of pg. 2 of paper No. 5 (applicant has made no amendments to the scope of claim 15 since the first office action with the exception of changing its dependency). Further note prosecution history at the middle of pg. 10 of applicant's paper No. 6.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



wp
October 28, 2002

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No. 617,929.

Patented Jan. 17, 1899.

O. E. FOWBLE,
FINGER SHIELD OR PROTECTOR.

(Application filed Aug. 22, 1898.)

(No Model.)

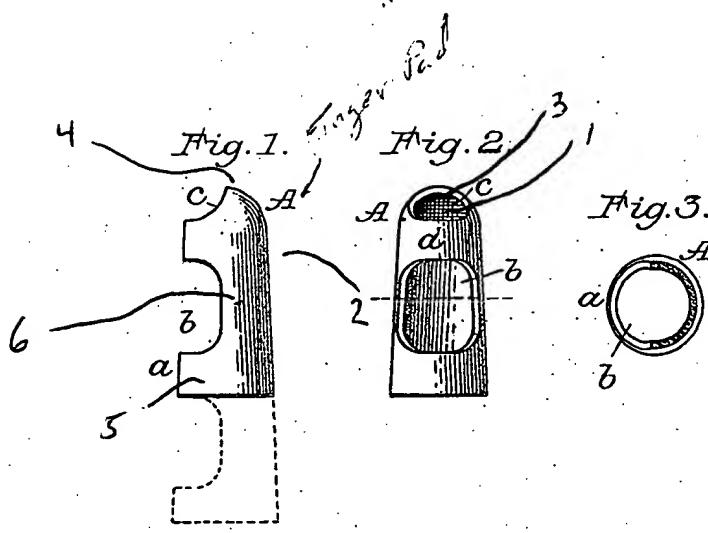


Fig. 4.

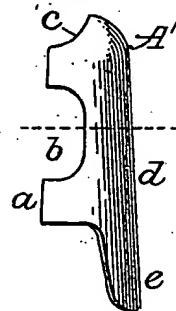
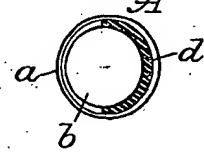


Fig. 5.



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